

**REMARKS**

Claims 1-18 are pending. Claims 1 and 15 have been amended and marked-up versions of the claims are attached pursuant to C.F.R. § 1.121.

**Affidavit rejection**

Applicant withdraws the previous Affidavit dated April 12, 2002, due to an error associated with Exhibit A. The notes provided as Exhibit A were not reduced to writing until March of 1998.

Applicant submits new Declarations by Steven Jenkins and James Melson as evidence that Applicant's invention was conceived prior to February 3, 1998.

**Rejections under 35 U.S.C. § 103**

**Claims 1, 7, and 8**

**Not all elements are taught or suggested**

Claims 1, 7, and 8 stand rejected under § 103(a) as being unpatentable over U.S. Patent No. 6,151,624 to Teare et al. ("Teare"), U.S. Patent No. 5,877,758 to Seybold ("Seybold"), U.S. Patent No. 6,192,407 to Smith et al. ("Smith"), U.S. Patent No. 6,266,695 to Huang et al. ("Huang"), U.S. Patent No. 5,918,014 to Robinson ("Robinson"), and U.S. Patent No. 6,094,649 to Bowen et al. ("Bowen"). As the PTO provides in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 1, as amended, recites specifying information for at least one matter of the client, wherein the matter conceptually links a plurality of related items and the specified information is applicable to each of the items. Nowhere do the cited references teach or suggest such an element. Accordingly, claim 1 is allowable over the cited references for at least this reason.

Furthermore, the Office action cites a number of text fragments from Teare to render obvious certain elements of claim 1. Applicant respectfully submits that at least some of the cited fragments fail to render Applicant's invention obvious.

For example, the Office action cites col. 4, lines 39-41 of Teare to render obvious the element of "configuring an appearance." However, the actual language of the cited text in Teare refers to configuring a system "in a way that provides distributed storage of the real name information." Configuring a system to provide distributed storage of the real name information does not teach or suggest configuring an appearance. Accordingly, claim 1 is allowable over the cited reference.

Furthermore, lines 27-30 of col. 8 of Teare are cited to render "specifying information for at least one matter" obvious. However, the cited text of Teare reads "[i]n the Subject attribute the Name File 64 stores information that describes the subject matter of the network resource, for example, 'dogs.'" In other words, the cited text refers to describing the subject matter of a single resource. In contrast, the at least one matter in amended claim 1 conceptually links a plurality of related items and the specified information is applicable to each of the plurality of items. Accordingly, the cited text of Teare does not teach or suggest the indicated element of claim 1 and claim 1 is allowable over the cited reference.

In addition, text at col. 4, lines 15-21 of Teare is cited to render obvious "selecting a user." However, the cited text of Teare states "[i]t is also desirable to have such a system that can automatically and immediately navigate or direct the user to a particular network resource, without providing or requiring the user to search through a list of results or matches. It is also desirable to have a flexible, simple way to associate a natural language word or 'real' name with a set of information." This text has nothing to do with "selecting a user." Accordingly, the cited text of Teare fails to teach or suggest the indicated element of claim 1, and claim 1 is allowable over the cited reference.

The cited text of Teare at col. 26, lines 56-58 fails to teach or suggest "displaying only items for which the selected user has been designated." Instead, the cited text describes that, for the purpose of generating statistics, "[t]he system parses the Name File and displays a list of all the real names in a new Web page that is sent to the client 70." The Name File is described as containing metadata, which "provides information that describes a Web page in a manner analogous to the manner by which a catalog card describes a book in a library" (see col. 6, lines 10-28). This clearly has nothing to do with "displaying only items for which the selected user has been designated." Therefore, the cited text fails to teach or suggest the indicated element of claim 1 and claim 1 is allowable over the cited reference.

The combination of references is improper

Furthermore, it is respectfully submitted that the combination of Teare, Seybold, Smith, Huang, Robinson, and Bowen is improper. According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For example, Teare is directed to a mechanism for associating metadata with network resources, and for locating the network resources in a language-independent manner. (See Abstract). To accomplish this, Teare relies on the use of at least two copies of documents (one stored on a server and one stored in a registry), as well as a “crawler” service and a “resolver.” (Abstract).

Seybold is directed to “[a] control device for adjusting multiple parameters associated with an element or item of a user interface in an easy and intuitive manner.” (Abstract). The term “collaborative management tool” is mentioned in passing, as is indicated by the fact that the term occurs only one time in the entire patent. Accordingly, Seybold fails to teach or suggest the design or use of a collaborative management tool.

Smith is directed to a “document delivery architecture [that] dynamically generates a private Uniform Resource Locator (URL) to distribute information.” (Abstract).

Huang is directed to a “telecommunications switch management system which contains a system manager building block in communication with a remote computer.” (Abstract).

Robinson is directed to automated collaborative filtering in world wide web advertising. More specifically, Robinson “combines techniques for: determining the subject's community, and determining which ads to show based on characteristics of the subject's community. The information used to determine whether a given individual should be in the subject's community is gleaned from the individual's activities in the interactive medium.” (Abstract).

Bowen is directed to “[m]ethods and systems ... for supporting keyword searches of data items in a structured database, such as a relational database. Selected data items are retrieved using an SQL query or other mechanism.” (Abstract).

Nowhere, in any of the cited references, is there an implicit or explicit teaching, suggestion, or motivation to combine or modify the teachings of the references to produce

Applicant's invention. Accordingly, Applicant submits that the combination of references is improper.

Also, the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Here, no such evidence has been presented. In addition, there is absolutely no teaching, suggestion or motivation to support the combination of Teare, Seybold, Smith, Huang, Robinson, and Bowen. There is also absolutely no evidence that supports how the specialized components of each reference are to be used with or integrated into the specialized components of each of the other references. For example, there is absolutely no indication as to how the Teare mechanism for associating metadata with network resources and for locating the network resources in a language-independent manner using multiple document copies, a crawler, and a resolver, is to be combined with Seybold's document delivery architecture that dynamically generates a private Uniform Resource Locator to distribute information or Bowen's methods and systems for supporting keyword searches of data items in a structured database.

The Office action cannot simply take bits and pieces of information from a reference, much less multiple references, and piece them together like a jigsaw puzzle to render a disclosed invention obvious. The case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

Furthermore, even if Teare, Seybold, Smith, Huang, Robinson, and Bowen could be properly combined (which they cannot, as has been illustrated above), the combination would destroy the operability of the various references. As provided in MPEP § 2143.01, "if [the] proposed modification would render the prior art invention being modified unsatisfactory for its

intended purpose, then there is no suggestion or motivation to make the proposed modification.” Also, “if the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *Id.* It is submitted that the combination proposed by the Office action would render the references unsuitable for their intended purpose and would change the principle of operation of the references for at least the following reasons.

Teare is directed to a mechanism for associating metadata with network resources, and for locating the network resources in a language-independent manner using multiple document copies, a crawler, and a resolver. In contrast, Seybold discloses a document delivery architecture that dynamically generates a private Uniform Resource Locator to distribute information. It would be non-trivial to alter the mechanism of Teare (that relies on multiple document copies, a crawler, and a resolver) with its disclosed delivery system to conform to the architecture of Seybold, and such an alteration would destroy the very nature of each approach.

In addition, the telecommunications switch management system disclosed by Huang is totally different (and in a different field of invention) from the Teare mechanism and Seybold architecture, as is Smith's document delivery architecture. Combining Huang and Smith with Teare and Seybold (which are only four of six references that must be combined to support the current rejection) requires a combination of four different approaches/architectures without changing the principle of operation of each of the references.

Furthermore, Robinson's automated collaborative filtering in the field of world wide web advertising and Bowen's method and systems for supporting keyword searches of data items in a structured database must also be combined with the previous four references while satisfying the guidelines of MPEP § 2143.01. Applicant submits that such a combination would require non-trivial modification of each of the references and that the modifications would render the references unsuitable for their intended purpose and would change the principle of operation of the references. Accordingly, Applicant submits that these references cannot be combined as required by MPEP § 2143.01 to render Applicant's invention obvious, and claim 1 is allowable over the cited references.

Claims 7 and 8 depend from and further limit claim 1 and therefore are allowable for at least that reason.

#### Claims 2-6 and 9-14

Claims 2-6 and 9-14 stand rejected under § 103(a) as being unpatentable over various combinations of Teare, Seybold, Smith, Huang, Robinson, and Bowen in view of other cited

references. However, as claims 2-6 and 9-14 depend from and further limit claim 1, claims 2-6 and 9-14 are allowable for at least that reason.

#### Claims 15-18

##### Not all elements are taught or suggested

Claims 15, 17, and 18 stand rejected under § 103(a) as being unpatentable over Teare, Smith, U.S. Patent No. 6,182,080 to Clements ("Clements"), U.S. Patent No. 6,253,234 to Hunt et al. ("Hunt"), and U.S. Patent No. 5,930,512 to Boden et al. ("Boden"). As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 15, as amended, recites instructions for accessing a repository, where the repository is for storing a plurality of documents. A first graphical interface enables a first user associated with a service provider to log into a network application, add one or more documents to the repository, and assign a category, an authorization, and a matter for each document. The matter conceptually links a plurality of related documents and information associated with the matter is applicable to each of the plurality of documents. The cited references, alone or in combination, fail to teach or suggest these elements as required by MPEP § 2143. Accordingly, claim 15 is allowable over the cited references.

##### The combination of references is improper

Furthermore, it is respectfully submitted that the combination of Teare, Smith, Clements, Hunt, and Boden is improper. As stated previously, according to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Teare is directed to a mechanism for associating metadata with network resources, and for locating the network resources in a language-independent manner. (See Abstract). To accomplish this, Teare relies on the use of at least two copies of documents (one stored on a server and one stored in a registry), as well as a "crawler" service and a "resolver." (Abstract).

Smith is directed to a "document delivery architecture [that] dynamically generates a private Uniform Resource Locator (URL) to distribute information." (Abstract).

Clements is directed to the storage of multiple documents and a tracking log within a single file. (Abstract). "More specifically, the present invention provides a convenient way to organize multiple documents and store them within a single file in a manner that facilitates exchange of the collection of documents and collaboration on the collection by a group of individuals." (Abstract).

Hunt is directed to shared web page caching at browsers for an intranet. More specifically, "[e]ach client in an intranet includes at least the minimum functionality required to serve a remote request such as an HTTP request. Existing browsers within the intranet may share their collective local caches to form a scalable cache. The intranet proxy routes page requests from one client within the intranet to another when a local cache within the intranet contains a current copy of the requested page. A trust protocol insures that clients serving as caches may be trusted by the proxy, while a refresh mechanism such as a time-out policy ensures that the page is reloaded after a predetermined period of time." (Abstract).

Boden is directed to process modeling using both a web server and a workflow server in process definition using a hypertext transfer protocol. (Abstract).

Nowhere, in any of the cited references, is there an implicit or explicit teaching, suggestion, or motivation to combine or modify the teachings of the references to produce Applicant's invention. Accordingly, Applicant submits that the combination of references is improper.

Also, the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolchem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Here, no such evidence has been presented. In addition, there is absolutely no teaching, suggestion or motivation to support the combination

of Teare, Smith, Clements, Hunt, and Boden. There is also absolutely no evidence that supports how the specialized components of each reference are to be used with or integrated into the specialized components of each of the other references. For example, there is absolutely no indication as to how the Teare mechanism for associating metadata with network resources and for locating the network resources in a language-independent manner using multiple document copies, a crawler, and a resolver, could be integrated with the disclosure of Clements that utilizes the storage of multiple documents and a tracking log within a single file, or with Hunt, which uses shared web page caching at browsers.

The Office action cannot simply take bits and pieces of information from a reference, much less multiple references, and piece them together like a jigsaw puzzle to render a disclosed invention obvious. The case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way the cited references could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

Furthermore, even if Teare, Smith, Clements, Hunt, and Boden could be properly combined (which they cannot, as has been illustrated above), the combination would destroy the operability of the various references. As provided in MPEP § 2143.01, "if [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Also, "if the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *Id.* It is submitted that the combination proposed by the Office action would render the references unsuitable for their intended purpose and would change the principle of operation of the references for at least the following reasons.

For example, Teare is directed to a mechanism that uses multiple document copies, a crawler, and a resolver to associate metadata with network resources and to locate the network resources in a language-independent manner. In contrast, Clements utilizes the storage of multiple documents and a tracking log within a single file, which is incompatible with the disclosed mechanism of Teare. It would be non-trivial to alter the mechanism of Teare (that relies on multiple document copies) and its associated resolver and crawler to conform to the



architecture of Clements (that relies on a structure using a single file for multiple documents). In fact, combining Teare and Clements would destroy at least one of the approaches, if not both, due to the conflict between the multiple document copy approach of Teare and the single file approach of Clements. Furthermore, Hunt, which uses shared web page caching at browsers, would effectively destroy the principle of document retrievability disclosed by Teare and Clements, as cached documents might be retrieved rather than a current document. Attempting to combine Smith's document delivery architecture and Boden's process modeling (which requires both a web server and a workflow server) would require additional non-trivial modifications and would further destroy the operability of at least most of the references. Applicant submits that such a combination would render the references unsuitable for their intended purpose and would change the principle of operation of the references. Accordingly, Applicant submits that these references cannot be combined as required by MPEP § 2143.01 to render Applicant's invention obvious, and claim 15 is allowable over the cited references.

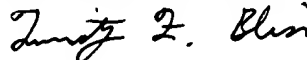
Claims 16-18 depend from and further limit claim 15 and therefore are allowable for at least that reason.

#### Conclusion

Therefore, it is respectfully submitted that independent claims 1 and 15 are in condition for allowance. Dependent claims 2-14 and 16-18 depend from and further limit independent claims 1 and 15 and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.


Respectfully submitted,



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on	December 13, 2002
	
Gayle Conner	

**Marked-up Claims Pursuant to CFR § 1.121**

1. (Amended) A method of implementing a collaborative management application, the method comprising:

- logging on to the collaborative management application;
- configuring an appearance of the collaborative management application; and
- viewing, adding, or modifying items of information pertaining to one or more clients;

wherein said configuring further comprises:

- specifying identifying information for a client;
- specifying information for at least one matter of the client, wherein the at least one matter conceptually links a plurality of related items and the specified information is applicable to each of the plurality of items;

- selecting a component in connection with all matters of the client;
- specifying at least one category for the component;
- identifying a user group for the client, the user group comprising a set of users having some level of authorization with respect to matters of the client;

wherein said viewing, adding, or modifying further comprises:

- selecting a client;
- selecting one or more matters in connection with the selected client, wherein the one or more matters comprise a group of matters;

- selecting a component in connection with the selected group of matters;
- selecting a filter for filtering items for the selected client, matters and component;
- displaying the filtered items to a user;
- selecting a user;
- displaying only items for which the selected user has been designated; and

wherein said configuring and said viewing, adding, or modifying are performed via an Internet web site.

15. (Amended) A software program for implementing a website by which documents can be shared between a service provider and a client, the software program comprising:

- instructions for accessing a repository, the repository for storing a plurality of documents;

a first graphical interface by which a first user associated with the service provider can log into the network application, can add one or more documents to the repository, and can assign a category, an authorization, and a matter for each document, wherein the matter conceptually

links a plurality of related documents and information associated with the matter is applicable to each of the plurality of documents;

instructions for identifying one or more clients, each client comprising one or more users having a level of authorization with respect to matters of the client;

an email interface linked to the first graphical interface, the email interface including a list of potential email recipients selected according to at least one client, the category and the matter;

a second graphical interface by which a second user associated with a client can log into the network application and can access one or more of the documents in the repository, based on the category, authorization, and matter for the one or more documents; and

instructions for allowing the second user to view, add, or modify any one of the documents in the repository according to the authorization of the second user with respect to a particular matter.